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Application No. 09/847937

Atty Docket: MKSI 1000-1

REMARKS

The title is presently objected to as not being descriptive.

All claims presently stand rejected. Applicants have added dependent claims 19-21. Claims 1-21 are currently pending.

Specification and Title

Three dependent device claims 19-21 have been added to conform the claims to the present title.

Claim Rejections under 35 USC 112

Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, particularly because they use the term "business logic." Clearly, this is a very broad term. However, MPEP section 2173.04 directs, "Breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if Applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph." As no lack of clarity is asserted, Applicants respectfully submit that the indefiniteness rejection should be withdrawn.

Claim Rejections under 35 USC 102

Claims 1-2, 4, and 6 are rejected under 35 USC 102(e) as being anticipated by Lektion et al. (USP 6,446,110). Much of the discussion that follows is directed to claim 1, as the Examiner's analysis of claim 1 and application of Lektion FIGs. 4, 12 and 13 are repeated for most of the pending claims.

The Examiner's 102(e) rejection of independent **claim 1** based on Lektion makes no reference to Lektion's description of converting a so-called host datastream into an XML datastream. Columns 7-8 describe a one-step conversion process:

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With reference now to FIG. 8, a flowchart depicts a process within an XML server for receiving and forwarding host datastreams and XML datastreams. The process begins when the XML server receives a host datastream (step 802). The XML server parses the host datastream (step 804) and generates an XML datastream that is properly tagged with the content from the host datastream (step 806). The XML server forwards the XML datastream to the appropriate client (step 808) and waits for the client to respond (step 810). A determination is then made as to whether a response has been received from a client (step 812). If not, then the process returns to step 810 to continue waiting for a client response. The XML server then receives the XML datastream from the client (step 814). The XML server then generates a host datastream that contains the content from the XML datastream received from the client (step 816). The XML server then forwards the newly generated XML datastream to the host (step 818). Steps 802-818 constitute an essentially non-terminating loop in which the XML server processes datastream traffic between the host and the client. In an alternative process, the XML server may continue processing other datastreams rather than waiting for a particular response from a particular client. In other words, the XML server may process multiple datastreams in parallel and asynchronously.

In this passage, the entire description of converting the host datastream into XML is in two sentences: "The process begins when the XML server receives a host datastream (step 802). The XML server parses the host datastream (step 804) and generates an XML datastream that is properly tagged with the content of the host datastream (step 806)." This brief reference to converting the host datastream into XML cannot be matched to or read upon the claimed steps. It does not anticipate each and every step of the claim.

The Examiner's reference to ambiguous FIGs. 4, 12 and 13 does not improve Lection's teaching of how to convert a host datastream into XML. Lection explains FIG. 4 with a single sentence regarding conversion, at column 6, lines 57-60. "Plug-in 424 executing with XML server 426 accesses or retrieves data comprising the host datastream 410 and converts the content into an appropriately tagged XML datastream

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that is forwarded to client 402." This sentence does not teach what is claimed. Column 10 presents examples of a host datastream (FIG. 12) and a resulting XML datastream (FIG. 13), without teaching any conversion process. In the descriptive text, "With reference now to FIGS. 13A-13C, an example of an XML datastream is shown. The content of the XML datastream is the login screen content shown in the emulator window in FIG. 11 after parsing and tagging the raw host datastream shown in FIG. 12." Col. 10, lines 14-18. It is apparent that Lektion's text describing the cited figures 4, 12 and 13 does not teach the claimed steps.

Applicants find no textual support for the Examiner's argument about how the figures might be interpreted to be equivalent to the claim. We suppose that the Examiner interprets the DTD table (Summary of Invention, col. 2; col. 9, lines 4-13), which contains attribute names, to be a context-setting message, and interprets the host datastream (410; FIG. 12), as including context-sensitive messages. This equivalence argument is inconsistent with Lektion's use of the term datastream. The DTD table is not a message and not part of either of Lektion's datastreams 410, 416. In FIGS. 10A-E, Lektion gives an example of a DTD table. One of skill in the art will recognize that the sample DTD table is stored as parsable XML-tagged data. Although Lektion omits this detail, the first line in a DTD table typically indicates the XML version used to store the table. Even if the DTD table were considered to be part of a datastream, which it is not, Lektion does not teach tagging the DTD table because the DTD table is already tagged in its native XML format.

We find no explanation in the Office Action for how the Examiner would meet the limitation, "*context-sensitive messages being meaningful only when matched with corresponding context-setting messages*". The messages in Lektion's host datastream are terminal display messages that a display terminal routinely interprets without translation into XML and without being matched to context-setting messages. At the top of column 10, Lektion explains that a terminal display message includes a command 1202 that informs an application to write the message to a display terminal, an order 1204 that sets the screen coordinates to write text, an order 1206 that sets the field attribute and a content portion 1208. The XML version of the message reformats the

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display command and orders 1202, 1204, 1206, 1208, without making them any more or less meaningful.

Therefore, Applicants respectfully submit that claim 1 should be allowable over Lektion.

The Examiner's 102(e) rejection of dependent **claim 2** expressly builds on the claim 1 analysis that is traversed above, so claim 2 should be allowable for at least the same reasons as claim 1. More specifically regarding claim 2, the Examiner argues that a passage beginning at col. 9, line 10 describes context-setting messages. This passage refers the DTD definition file, which cannot qualify as part of a datastream of structured messages including context-setting messages. A DTD definition file cannot qualify because it is not part of Lektion's datastream, as described above. It also cannot qualify because it begins as an XML tagged file and does not read on "*tagging the structured messages with XML tags corresponding to the structure of the messages*". Lektion does not describe any process of tagging the DTD file with XML tags.

For these additional reasons, claim 2 should be allowable over Lektion.

The Examiner's 102(e) rejection of dependent **claim 4** expressly builds on the claim 1 analysis that is traversed above, so claim 4 should be allowable for at least the same reasons as claim 1. More specifically regarding claim 4, it is useful to have some of the claim limitations clearly in mind:

the context-setting messages include report definition messages and report trigger messages, said report definition messages including a report identifier and one or more variable identifiers and said report trigger messages including an event identifier and one or more report identifiers;

the context-sensitive messages include report messages generated upon occurrence of an event associated with the event identifier, said report messages including the report identifier and variable values but not the variable identifiers

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The Examiner again refers to col. 9, line 10. As the limitations are detailed, it is worth having the text from Lektion at hand for comparison:

DTD and in what context the tags and attributes are valid. An attribute is a name="value" pair that can be placed in the start tag of an element. In the present invention, the set of tags in the DTD provides meaning to the data, which represents the field structure of the host screen.

In this passage, Applicants do not find a context setting message in a datastream, any report definition messages, any report trigger messages, any event identifiers, any context sensitive messages, or any variable values not associated with "name='value'". Applicants cannot see how a DTD table that is not part of a datastream can read on the limitations set forth above.

For these additional reasons, claim 4 should be allowable over Lektion.

The Examiner's 102(e) rejection of dependent **claim 6** expressly builds on the claim 1 analysis and repeats the claim 4 analysis that are traversed above, so claim 6 should be allowable for at least the same reasons as claims 1 and 4.

Claims 17 and 18 are also rejected under 35 USC 102(e) as being anticipated by Lektion et al. (USP 6,446,110). The Examiner argues that "Lektion teaches conversion [Figure 4] of a raw datastream [Figure 12] to a XML data stream [Figure 13]." But the Examiner in paragraph 15 of the Office Action does not point to any passages in the specification to support his view of what Lektion teaches. The cited figures are a block diagram (FIG. 4), an input datastream (FIG. 12) and an output datastream (FIG. 13). These kinds of figures cannot teach the multi-step tagging, matching and re-tagging process that is claimed. The only way to combine these figures match to claim 17 is by using the claimed invention as a roadmap for making up a story about what the diagrams might show, which is not a sufficient basis for rejecting the claims.

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Again, Applicants find no textual support for the Examiner's argument that the figures might be interpreted to be equivalent to claim 17. Lektion explains FIG. 4 with a single sentence description of conversion, at column 6, lines 57-60. "Plug-in 424 executing with XML server 426 accesses or retrieves data comprising the host datastream 410 and converts the content into an appropriately tagged XML datastream that is forwarded to client 402." This does not teach what is claimed. Column 10 presents examples of a host datastream (FIG. 12) and a resulting XML datastream (FIG. 13), without teaching any conversion process. "With reference now to FIGS. 13A-13C, an example of an XML datastream is shown. The content of the XML datastream is the login screen content shown in the emulator window in FIG. 11 after parsing and tagging the raw host datastream shown in FIG. 12." Col. 10, lines 14-18. So Lektion's text explaining the cited figures does not teach the claimed steps.

Therefore, Applicants respectfully submit that claim 17 and dependent claim 18 should be allowable over Lektion.

Claim Rejections under 35 USC 103

Claims 3, 5, 7-14 are rejected under 35 USC 103(a) as being unpatentable over Lektion in view of Burney (USP 4,829,445). Claim 15 is rejected under 103(a) as being unpatentable over Lektion and Lo as applied to claim 15 and further in view of Burney.

As a preliminary matter, it does not appear that Lektion and Burney are drawn from analogous arts, such that one of skill in the art would look from Lektion to Burney for inspirations to improve on Lektion. Lektion gives as its Technical Field, "The present invention relates generally to an improved data processing system and, in particular, to a method and apparatus for representing screen data from a host computer using a markup language. Burney is far afield, stating, "The present invention relates to automated factories and, in particular, to a system and method for flexible, operatorless manufacturing." Burney does not mention XML in 130 pages of patent. Burney is not from a field analogous to either the claimed invention or Lektion, and is irrelevant to translation of a datastream into XML. This removes Burney as a reference.

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Claim 3 is rejected under 35 USC 103(a) as being unpatentable over Lection in view of Burney (USP 4,829,445). The analysis expressly builds on the claim 2 analysis that is traversed above, so claim 3 should be allowable for at least the same reasons as claim 2.

Specifically regarding claim 3, it is unclear to Applicants just how the Examiner would add Burney to Lection. Look for instance to Lection FIG. 4, to which the Examiner has made repeated reference. In which step would an SVID table be added? How would it improve on Lection's method of translating an input data stream for display on a display screen?

It is important to remember that the proposed combination of references must not render Lection unsuitable for its intended purpose or change its principle of operation. "A proposed modification should not 'destroy a reference' by rendering the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1 127 (Fed. Cir. 1984)." Barry R.A. Weinhardt, M. Reinhart, *Obviousness Under 35 U.S.C. 103 Basic Student's Manual*, p. 24 (U.S. P.T.O. Office of Patent Policy Dissemination, Rev. 4 1998); explaining, M.P.E.P. 2143.01 and 2145, paragraph (j)(4). Any modification of Lection to use an SVID table referencing SECS variable names to modify labels sent to a terminal emulator would be improper because it would render Lection unsuitable for its intended purpose of terminal emulation using consistent XML tags. M.P.E.P. 2143.01 and 2145, paragraph (j)(4); see Barry et al., *Obviousness Under 35 U.S.C. 103, supra*, pp. 24-25. In addition, the modification would be improper because it would change the principle of operation emphasized by Lection. M.P.E.P. 2143.01; see Barry et al., *Obviousness Under 35 U.S.C. 103, supra*, pp. 25-26.

Using an SVID table referencing SECS variable names to modify labels sent to a terminal emulator would improperly change Lection's principle of operation by destroying the consistent labeling used to specify display placement for the terminal emulator. This would change the basic principle of operation in Lection. "As a proposed modification or combination of the prior art should not destroy a reference, the proposed modification or combination should not change the principle of operation of the

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reference. *In re Ratti*, 270 F. 2d 8 10, 8 13, 123 USPQ 349, 352 (CCPA 1959). This is true even if the combination proposed is operative." Barry et al., *Obviousness Under 35 U.S.C. 103*, *supra*, pp. 25-26; explaining, M.P.E.P. 2143.01.

Moreover, the Examiner has not offered any evidence of motivation, other than in the teaching of this application, to combine Lektion's terminal emulation technology with Burney's assembly line automation technology. It is fundamental, as indicated in MPEP § 2143.01, that the Examiner rely on some evidentiary quality suggestion to produce the claimed combination:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

This section of the MPEP cites the no-longer recent case *In re Lee*, in which the Federal Circuit clarified the need for evidentiary quality support of an Examiner's factual basis for finding a teaching, suggestion or motivation in the prior art (as opposed to the Examiner's opinion), 277 F.3d at 1343-44:

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). ... "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citation omitted] The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the

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skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). ... In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

Under *In re Lee*, it is not enough for the Examiner to announce the apparent advantage of the claimed invention and rely on his own announcement derived from the application, in the absence of some evidentiary quality teaching or suggestion, as motivation to combine two references. No evidentiary quality support for combining references is found in this rejection.

For these additional reasons, claim 3 should be allowable over Lektion in view of Burney.

The Examiner's 103(a) rejection of dependent **claim 5** expressly builds on the claim 4 analysis under Section 102(e) that is traversed above, so claim 5 should be allowable for at least the same reasons as claim 4. In addition, the Examiner repeats the claim 3 arguments traversed above, so claim 5 should be allowable for the additional reasons given for claim 3, including that Burney is not analogous art and not combinable with Lektion under Section 103(a), because doing so would destroy the Lektion reference and change its principle of operation.

For these reasons repeated from above, claim 5 should be allowable over Lektion in view of Burney.

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The Examiner's 103(a) rejection of dependent **claim 7** expressly builds on the claim 6 analysis that is traversed above, so claim 7 should be allowable for at least the same reasons as claim 6. In addition, the Examiner repeats the claim 3 arguments traversed above, so claim 7 should be allowable for the additional reasons given for claim 3, including that Burney is not analogous art and not combinable with Lektion under Section 103(a), because doing so would destroy the Lektion reference and change its principle of operation.

For these reasons repeated from above, claim 7 should be allowable over Lektion in view of Burney.

The Examiner's 103(a) rejection of dependent **claim 8** expressly builds on the claim 1 analysis that is traversed above, so claim 8 should be allowable for at least the same reasons as claim 1. Specifically regarding claim 8, the Examiner proposes to feed Burney's SECS messages for controlling assembly line automation into a terminal emulator. Applicants are not sure if the Examiner really means this. In any case, it would be as productive directing a garden hose into a PC power supply, instead of connecting the PC to an outlet.

For this additional reason, claim 8 should be allowable over Lektion in view of Burney.

The Examiner's 103(a) rejection of dependent **claim 9** expressly builds on the claim 8 analysis that is traversed above, so claim 9 should be allowable for at least the same reasons as claim 8, including that Burney is not analogous art and not combinable with Lektion under Section 103(a), because doing so would destroy the Lektion reference and change its principle of operation. In addition, the Examiner repeats the claim 2 arguments traversed above, so claim 9 should be allowable for the additional reasons given for claim 2.

For these reasons repeated from above, claim 9 should be allowable over Lektion in view of Burney.

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The Examiner's 103(a) rejection of dependent **claim 10** expressly builds on the claim 9 analysis that is traversed above, so claim 10 should be allowable for at least the same reasons as claim 9, including that Burney is not analogous art and not combinable with Lektion under Section 103(a), because doing so would destroy the Lektion reference and change its principle of operation. In addition, the Examiner repeats the claim 3 arguments traversed above, so claim 10 should be allowable for the additional reasons given for claim 3.

For these reasons repeated from above, claim 10 should be allowable over Lektion in view of Burney.

The Examiner's 103(a) rejection of dependent **claim 11** expressly builds on the claim 10 analysis that is traversed above, so claim 11 should be allowable for at least the same reasons as claim 10, including that Burney is not analogous art and not combinable with Lektion under Section 103(a), because doing so would destroy the Lektion reference and change its principle of operation. In addition, the Examiner repeats the claim 4 arguments traversed above, so claim 11 should be allowable for the additional reasons given for claim 4.

For these reasons repeated from above, claim 11 should be allowable over Lektion in view of Burney.

At paragraphs 40-42, the Examiner repeats his **claim 10** arguments, which are traversed above without being repeated here.

The Examiner's 103(a) rejection of dependent **claim 13** expressly builds on the claim 8 analysis that is traversed above, so claim 13 should be allowable for at least the same reasons as claim 8, including that Burney is not analogous art and not combinable with Lektion under Section 103(a), because doing so would destroy the Lektion reference and change its principle of operation. In addition, the Examiner repeats the claim 4 analysis under Section 102(e) that is traversed above, so claim 13 should be allowable for the additional reasons given for claim 4.

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For these reasons repeated from above, claim 13 should be allowable over Lection in view of Burney.

The Examiner's 103(a) rejection of dependent claim 14 expressly builds on the claim 13 analysis that is traversed above, so claim 14 should be allowable for at least the same reasons as claim 13, including that Burney is not analogous art and not combinable with Lection under Section 103(a), because doing so would destroy the Lection reference and change its principle of operation. In addition, the Examiner repeats the claim 3 arguments traversed above, so claim 14 should be allowable for the additional reasons given for claim 3.

For these reasons repeated from above, claim 13 should be allowable over Lection in view of Burney.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lection in view of Lo et al. (US. Pub. No. 200410123302). The Examiner's only supporting reference from Lection is to FIG. 4 and not to any text of the Lection specification. Lection explains FIG. 4 with a single sentence description of conversion, at column 6, lines 57-60. "Plug-in 424 executing with XML server 426 accesses or retrieves data comprising the host datastream 410 and converts the content into an appropriately tagged XML datastream that is forwarded to client 402." This does not teach what is claimed in claim 15. The figure is not clear enough to support the Examiner's proposed interpretation and the explanatory text, recited above, does not support the Examiner's interpretation, either.

The Examiner proposes to combine Lection with Lo paragraph [0079] to meet the limitation, "*checking the field tagged messages for data format and data validity checking utilizing tools adapted to XML formatted messages*". The text and context of Lo ¶ 79 make it clear that data validity checking is not performed on "field tagged messages" and is not performed using tools adapted to XML formatted messages. The text reads:

The ERP application loads a panel using the data. (IX) The ERP application uses the panel to process data (a) to check data

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validity/relationship etc., and (b) to instruct the database manager to retrieve data base on data from the object request sent from the web browser to the web server. (XI)

FIG. 2 shows that (IX, XI) is data passed from ERP application 18 to database management system (unnumbered) and back as a "panel". There is no indication that this API call from the ERP application to the DBMS passes or returns *field tagged data*, and that is not what one of ordinary skill in DBMS programming would expect. The data does not become XML, HTML or tagged data until (XIV) after the Web Gateway 16 translates it. There is no indication that *data validity checking utilizing tools adapted to XML formatted messages* are used on the non-XML data (IX, XI).

As neither Lektion nor Lo meets the limitations to which the Examiner would apply them, claim 15 should be allowable over the combination.

The Examiner's 103(a) rejection of dependent **claim 16** expressly builds on the claim 15 analysis that is traversed above, so claim 16 should be allowable for at least the same reasons as claim 15, including that Burney is not analogous art and not combinable with Lektion under Section 103(a), because doing so would destroy the Lektion reference and change its principle of operation. In addition, the Examiner repeats the claim 3 arguments traversed above, so claim 16 should be allowable for the additional reasons given for claim 3.

For these reasons repeated from above, claim 16 should be allowable over Lektion in view of Lo and further in view of Burney.

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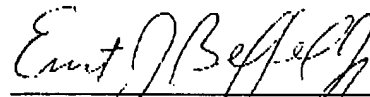
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CONCLUSION

Should any questions arise, the undersigned can ordinarily be reached at his office at 650-712-0340 from 8:30 to 5:30 PST, M-F and can be reached at his cell phone 415-902-6112 most other times.

Respectfully submitted,



Ernest J. Beffel, Jr., Reg. No. 43,489

Dated: 5 January 2005

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
(650) 712-0340 phone
(650) 712-0263 fax